REMARKS

Claims 1-13 and 15-19 are pending in the application.

Claims 14 and 20-25 have been withdrawn, but not canceled.

Claims 1-13 and 15-19 have been rejected.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-3, 7-13 and 15-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Emery, et al. ("*Emery*") (US 5,727,057). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Emery recites an enhanced Calling Number Delivery (CND) service that includes the Location ID of the caller and called party in the calling party identity information. (*Col 7, Lines 25-33*). The Calling Name, Calling Number and Location ID are transmitted during the ringing cadence. (*Col. 7, Line 34 - Col. 8, Line 14*).

Emery lacks any mention of "a location information sharing request" that is received from a first communication device "during the pendency of a call," as recited in Claims 1, 13, 15 and 16.

In *Emery*, the calling party identity information is ascertained and sent to the called party with the ringing of the call, not during the pendency of the call. In addition, as is understood in the art, the CND service is subscribed to by subscribers prior to making or receiving any calls. As a result, there is no teaching or suggestion in *Emery* of "a location information sharing request" that is sent by a communication device "during the pendency of a call."

For at least these reasons, *Emery* fails to anticipate the Applicant's invention as recited in Claims 1, 13, 15 and 16 (and their dependents). Accordingly, the Applicant respectfully request withdrawal of the § 102(b) rejection of Claims 1-3, 7-13 and 15-19.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over by Emery, et al. ("*Emery*") (US 5,727,057) in view of Norris et al. ("*Norris*") (US 5,805,587). The rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP

§ 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above, *Emery* fails to disclose, teach or suggest "a location information sharing request" that is received from a first communication device "during the pendency of a call," as recited in Claim 1. The Office Action does not cite *Norris* as disclosing, teaching or suggesting the elements of Claim 1.

The Applicant notes that Claim 4-6 are directly or indirectly dependent upon Claim 1, and therefore, for at least the reasons recited above with respect to Claim 1, the Office Action fails to establish a *prima facie* case of obviousness against Claims 4-6.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 4-6.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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